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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,681	01/13/2004	Tomoaki Yamashita	P/3541-54	3122
2352	7590	10/20/2005	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			ROBINSON, MARK A	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/756,681	Applicant(s) YAMASHITA, TOMOAKI	
	Examiner Mark A. Robinson	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,11,18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,8,17,21 and 23 is/are rejected.
- 7) ☒ Claim(s) 4,7,9,10,12-16,19 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/13/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of the species shown in fig. 3 in the reply filed on 8/19/05 is acknowledged.

Applicant stated that claims 1,2,4,6-10,12 and 14-23 read on the elected species. However, claim 18 recites the image projection device shown in fig. 5, and claim 20 includes the diffusion plate of non-elected claims 5 and 13. Accordingly, claims 1,2,4,6-10,12,14-17,19 and 21-23 read on the elected species and will be examined as follows.

The remaining claims are withdrawn from consideration as being directed to non-elected subject matter.

### ***Claim Objections***

2. Claims 1,2,4,6-10,12,14-17,19 and 21-23 are objected to because of the following informalities. Appropriate correction is required.

In claims 1 and 9, it is unclear exactly what is meant by "stride(s) over" in relation to the support member. For examination purposes, this will be interpreted broadly as "over or around." The dependent claims inherit this deficiency.

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In claim 17, "the outside space" lacks antecedent basis, and it is unclear what this references. The dependent claims inherit this deficiency.

In claims 21 and 23, "the stereoscopic microscope main body" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,6,8,17,21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ives (US 739,182).

Ives shows a stereoscopic microscope including an objective(3), splitter(6/7) dividing the flux transmitted through the objective, a lens body(1,etc.) holding the objective and splitter, an image forming device(17) on the path of one of the divided fluxes, and a support member(13-16) for the imaging device which "strides over" at least part of the optical path exposed to the outside of the lens body.

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Regarding claims 6 and 8, note that the distance and angle between the image forming device and the main body(1) is variable (via 13-16).

Regarding claim 17, Ives also shows an observation mechanism including a projection device(6-8) and an image forming device(17) opposite the projection device through "the outside space."

Regarding claims 21 and 23, note that the distance and angle between the image forming device and the main body(1) is variable (via 13-16).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ives.

Ives further shows a beam splitter(6/7), but does not show an image forming lens forming an image of a divided luminous

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flux to be imaged by the image forming device. However, it would have been obvious to the ordinarily skilled artisan at the time of invention to add a well known relay-type lens to Ives' system, thus satisfying the limitation of an optical image forming lens, in order to enable extension of the optical path or inversion of the image.

***Allowable Subject Matter***

7. Claims 9,10 and 12-16 would be allowable if rewritten or amended to overcome the objections set forth in this Office action.

8. Claims 4,7,19 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if the objections are overcome and if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or suggest the transparent type Fresnel lens as set forth in the combination of claim 4 or 19, or the specific arrangement for the changing image forming distance as set forth in the combination of claim 7 or 22, or the particular image forming means cooperating with the support means as set forth in the

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combination of claim 9. It should be noted that claim 9 is being interpreted in accordance with 35 U.S.C. 112, 6<sup>th</sup> paragraph.

10. Claim 9 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claim 13 is no longer withdrawn from consideration and is allowable as noted above since this claim depends from or otherwise includes each of the limitations of an allowed generic claim. In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### **Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to

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Ito, Biber, Morita, Kitajima, and Hatae all show various arrangements for microscope image forming devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

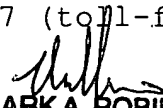
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MR

10/18/05

  
MARK A. ROBINSON  
PRIMARY EXAMINER